

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/607,921

Attorney Docket No.: Q58681

REMARKS

This Amendment, filed in reply to the Office Action dated July 26, 2005, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-6, 8-12 and 15-31 remain pending in the application. Claims 1-3, 17, 19, 22-24 and 27-29 have been allowed. Claims 4-6, 8-9, 11-12, 15-16, 18, 20-21, 25-26 have been rejected under 35 U.S.C. § 103 as being unpatentable over Honda (previously of record). Claim 10 has been rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Luo. Claims 30-31 have been rejected under 35 U.S.C. § 103 as being unpatentable over Honda in view of Hishinuma (U.S.P. 4,683,377). Applicant respectfully submits the following comments in traversal of the prior art rejections.

As previously discussed, an exemplary embodiment of the invention includes the transfer of an original image to an output device prior to the operation-processed image being obtained from a predetermined operation. This allows a preliminary diagnosis to be performed without the wait for the processing operation on image data to be completed. This feature is described by independent claims 4 and 8. The amendments set forth herein merely make more explicit features of the prior pending claims. Therefore, the claim amendments should be entered as a matter of course because they raise no new issues in need of further consideration.

The Examiner avers that Honda generally teaches an input device, a processing device, an output device and a transfer device. The Examiner now states that the functional aspects of claims 4 and 8 are not being considered and omits any analysis of how these features are taught

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in Honda. The Examiner's rejection also suggests that the functional aspects claimed are inherent in the device of Honda. However, the Examiner cannot ignore the recitations of the wherein clauses that describe the interaction between the transfer device, processor and output device as claimed. In particular, the transfer device transfers at least one original signal to the output device prior to the operation-processed image being obtained from the operation processing. Applicant submits that this interaction between the elements results in the elements having a structural relation that permits them to operate in the manner claimed.

Furthermore, the Examiner's reliance on inherent disclosure of the operational features of the claim elements is not supportable. Honda displays an original signal when an operator outputs a signal S_0 to switching element 15. Col. 4, lines 55-61. In Honda, the output of the processed signal S_m is provided until an operator transmits an operation signal. The relative timing of claim 4, to provide an original signal prior to the processed signal is not an inherent aspect of the operation of the Honda apparatus.

Relatedly, Applicant submits that in the case In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), the Federal Circuit reversed a prior art rejection where the Board of Patent Appeals did not give sufficient consideration to the operational relationships between claim elements. In Mills, the claims in question recited a functional relationship between the rate at which materials were fed into a device and the rate at which materials were pumped out of the device. The Board reasoned that the presence of a separate input pump and output pump would permit the prior art device to fulfill the relational operation as described in the claim. The Federal Circuit reversed. Despite the presence of an input pump and output pump in the reference and the possibility that the pumps could be operated as claimed, the prior art made no suggestion for providing the

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claimed operation. Applicant submits that this is an analogous situation where the output of an original signal prior to output of the processed signal is relational feature not taught or suggested in Honda. Therefore, claim 4 is patentable for at least this reason. Honda does not teach the transfer parts of first and second part as claimed. Claim 8 is patentable due to analogous recitations, and the remaining claims are patentable based on their dependency.

The secondary references of Luo and Hishinuma do not make up for the deficiencies of Honda. With further regard to claims 30-31, these claims describe parallel input or output relative to first and second original image data. The Examiner concedes that Honda teaches sequential, rather than parallel, processing of image and cites Hishinuma to make up for this deficiency. The Examiner cites in particular, col. 5, lines 41-67. However, the cited portion also describes sequential reading of images, not parallel operation as claimed. Therefore, claims 30-31 are patentable for this additional reason.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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